

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 29997/065	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>Filed electronically on 2/25/2011</u> Signature <u>/TPRiley/</u>		Application Number 10/743,443	Filed December 19, 2003
Typed or printed name <u>Thomas P. Riley</u>		First Named Inventor Jose Luis Moctezuma Barrera Art Unit 3686	
		Examiner Rajiv J. Raj	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. (See 37 CFR 3.71, Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/66) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>50,556</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </div> <div style="width: 45%; text-align: right;"> <u>/TPRiley/</u> Signature <u>Thomas P. Riley</u> Typed or printed name <u>312-263-4700</u> Telephone number <u>February 25, 2011</u> Date </div> </div>			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Applicant: Moctezuma de la Barrera

Serial No.: 10/743,443

Filed: December 19, 2003

For: Reactive Workflow System and Method

Group Art Unit: 3686

Examiner: Rajiv J. Raj

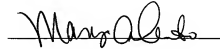
Docket No.: 29997/065

Customer No.: 29471

Certificate of Transmission

I hereby certify that this paper is being electronically
transmitted via EFS- Web on:

February 25, 2011



Pre-Appeal Brief Request for Review

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to clear errors in the final Office action mailed October 26, 2010, please consider the following points in support of this Pre-Appeal Brief Request for Review:

- 1. The rejections of claims 35 and 37-50 as being directed to non-statutory subject matter under 35 U.S.C. § 101 are clear legal error under the Supreme Court decision in *Bilski v. Kappos*.**

Claims 35 and 37-50 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. These rejections are traversed as clear legal error.

Under 35 U.S.C. § 101, “[w]hoever invents a new and useful process . . . may obtain a patent therefore, subject to the conditions and requirements of this title.” In *Bilski v. Kappos*, 130 S. Ct. 3218 (2010), the Supreme Court clarified that there are only three specific judicially created exceptions to the plain meaning of this statutory right: laws of nature; physical phenomena; and abstract ideas. *Id.*, at 3225. Further, although the machine-or-transformation test is a useful clue as to patent eligibility of process claims under § 101, it is not the sole test for deciding whether an invention is patent eligible. *Id.*, at 3227. However, a “claimed process is surely patent-eligible under

35 U.S.C. § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *In re Bilski*, 545 F.3d 943, 952 (Fed. Cir. 2008) (en banc), *aff’d sub nom. Bilski v. Kappos*, 130 S. Ct. 3218 (2010).

With regard to claims 35 and 37-50, there is no suggestion on the record that the claimed invention is merely a law of nature, physical phenomena, or an abstract idea. Further, independent claims 35 and 37 each recite a method “performed by a computer navigation system”, wherein the computer navigation system performs various steps recited by the claims. The recitation of the “computer navigation system” is not mere insignificant post-solution activity, but rather is central to the operation of the entire invention in that the computer navigation system comprises each of the recited means recited thereafter. In addition, each of independent claims 35 and 37 recites the step of displaying a representation related to a consequent step on a display screen. The transformation of raw data into a particular visual depiction of a physical object on a computer display screen is sufficient to render a claimed process invention patent eligible. *See, e.g., In re Bilski*, 545 F.3d at 962. Consequently, the methods of claims 35 and 37-50 are not reciting merely an abstract idea; in fact, they are tied to at least one particular machine and transform at least some matter, all in accordance with the Supreme Court decision in *Bilski v. Kappos*. Therefore, the rejections under 35 U.S.C. § 101 are clear legal error and should be withdrawn.

2. The rejections of claims 16 and 37 as being indefinite under 35 U.S.C. § 112 are based on a clear error of law.

Independent claims 16 and 37 and all claims dependent thereon also stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicant regards as the invention. Specifically, it is alleged in the Office action that “[i]t is unclear to the Office what ‘*identifying the consequent step*’ mean[s], and further what step is being identified or what step is the consequent step” (emphasis in original). This is a clear error of law.

The word “identifying” has a clear and well known meaning in the English language and need not be elaborated in detail herein. Further, a commonly understood and accepted meaning of the word “consequent” applicable in the present context is: “following [especially] as a result”. Webster’s Third New International Dictionary, 483 (2002). Therefore, under a construction consistent with standard recognized English usage and in context with the claim language as a whole

and the specification, the “consequent step” is the step that follows as a result of a determination made by the computer navigation system. The determination relates to which step in the multi-step operation should be displayed on the navigation screen at any given time as a consequence of the then present conditions. In the present invention, the consequent step to be performed after the current step can be a step other than the current step or the next step, such as the previous step or a step after the next step, depending on, among other things, what tool is identified by the computer navigation system and what the identity of the current step is. Thus, the step of determining a consequent step involves determining what step out of several possible choices should be performed next as a consequence of the present conditions recited.

The objected-to words of the claim, “identifying the consequent step,” are clear, concise, have well recognized meanings in the English language, and are well within the understanding of a person of ordinary skill in the art in view of the specification and the claim language as a whole. Therefore, this rejection is based on a clear error of law and should be withdrawn.

It should be noted that this rejection would also be overcome by the amendments presented in Amendment G, which replace the term “identifying” with the previously used and accepted term “determining,” as explained in detail below.

3. The amendment to claim 16 as presented in Amendment G after final would have overcome both 35 U.S.C. § 112 rejections of claim 16 for lack of antecedent basis and for indefiniteness without requiring undue search and examination by the Examiner or raising any significant new issues and therefore should be entered for purposes of this appeal.

Claim 16 is also rejected under 35 U.S.C. § 112 for lack of antecedent basis as to the claim’s recitation of the limitation “the consequent step”. The undersigned points out that the Applicant has already submitted a very minor amendment to claim 16 in the Amendment G submitted after final on December 20, 2010, that would have sufficiently corrected this problem, but that the examiner refused to enter this amendment. Further, entry of this amendment would have simply returned the term “identifying” back to the previously used term “determining.” No new issues would have been raised since the term “determining” had already been examined and fully considered by the examiner in previous forms of the exact same claim. The undersigned requests that the Amendment G be entered in order to easily and readily remove this issue from contention and place the application in better and cleaner position for appeal.

4. Malackowski does not disclose analyzing a step other than the current step or an immediately subsequent step.

It is also averred in the Office action that Malackowski discloses the limitation of a means for analyzing or the step of analyzing “a step other than the current step or an immediately subsequent step” as recited variously in claims 16, 35, and 37. However, Malackowski does not disclose such limitation. In addition, the Examiner does not cite to either Van Der Brug or DiGioia to support his rejections, and neither reference discloses or suggests the aforementioned limitation. Accordingly, these rejections are also traversed for these additional errors of fact.

The rejections of claims 16, 35, and 37 are supported, in part, on the language contained in claim 19 of Malackowski. Claim 19, however, merely disclose that a series of steps are performed in a specific sequence, and that after a certain determination is made in the current step, the next step is performed. That portion of Malackowski therefore at most suggests that the surgical navigation system advances to the next step in a multi-step surgical procedure based on the results of the current step. The reasoning in the Office action also relies on Fig. 21 and “Items:350 & related text” to support the rejections of claims 16, 35, and 37. Those sections, however, merely illustrate how the surgical navigation system in Malackowski receives and uses data from various components to assist the surgeon during the surgical procedure. Further, the reasoning relies on paragraphs [0154-0158] of Malackowski to support the rejection of at least claim 35. However, paragraphs [0154-0158] simply describe a procedure wherein, at each step of the surgical procedure, the surgical navigation system determines only if it is appropriate to advance to the immediately next step of the procedure. The aforementioned portions of Malackowski do not disclose or suggest that the navigation system analyzes whether a tool or component for use in the surgical procedure is acceptable for use in any steps other than the current step or the immediately next step of the procedure. Furthermore, Van Der Brug and DiGioia do not supply this deficiency pointed out in Malackowski. Therefore, those sections of Malackowski do not supply the deficiencies identified herein, and the allegations to the contrary in the pending Office action are traversed as errors of fact.

5. Malackowski does not disclose a step of determining the consequent step based on the location, the identity of the component, and the identity of the current step.

It is alleged on page 11 of the Office action that Malackowski discloses the step of “*determining the consequent step based on the location, the identity of the component, and the identity of the current step*; (see at least Malackowski [0087]”, as recited in claim 35. This

allegation is traversed as a clear factual error.

In fact, paragraph [0087] of Malackowski discusses how a surgical navigation system uses data contained in a chip in a cutting accessory to configure the system so that it operates in a particular manner given the specific characteristics of the cutting accessory. The system is configured so that, for example, a hand piece motor will run at a preferred speed and in a preferred mode for the cutting accessory when the system identifies the cutting accessory. Malackowski, therefore, at most discloses that attributes used in the next step of the pre-determined sequence are based on the location and identity of the component. Malackowski does not mention in paragraph [0087] or elsewhere that a step of determining the consequent step, which can be a step other than the current or immediately subsequent step, is based on the location and identity of the component.

Further, because Malackowski does not disclose the limitation of "identifying a current step" as conceded in the Office action, it is factually impossible for Malackowski to disclose that the next step is based on the location, identity of the component, and the identity of the current step. Thus, Malackowski does not disclose the deficiency identified herein, and the allegation to the contrary in the pending Office action is traversed as being clear factual error.

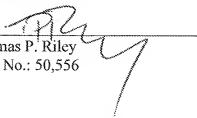
Conclusion

Because of these clear errors of fact and law, the applied references do not disclose or suggest every element of claims 16, 35, and 37, and all claims dependent thereon, the applied references do anticipate or render obvious the claims at issue, and the pending rejections should be withdrawn.

Respectfully submitted,

McCracken & Frank LLP
311 S. Wacker Dr., Suite 2500
Chicago, Illinois 60606
(312) 263-4700
Customer No.: 29471

February 25, 2011

By: 
Thomas P. Riley
Reg. No.: 50,556